

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/303,232	04/30/99	ADAMCZEWSKI	M MU-5176/LEAD

BAYER CORPORATION  
PATENT DEPARTMENT  
100 BAYER ROAD  
PITTSBURGH PA 15205

HM22/0220

EXAMINER  
SCHNIZER, R

ART UNIT	PAPER NUMBER
1632	18

**DATE MAILED:** 02/20/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Advisory Action</b>	Application No. 09/303,232	Applicant(s) Adamczewski et al
	Examiner Richard Schnizer	Group Art Unit 1632

## THE PERIOD FOR RESPONSE: [check only a) or b)]

a)  expires 3 months from the mailing date of the final rejection.

b)  expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

**Applicant's response to the final rejection, filed on Nov 8, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

The proposed amendment(s):

will be entered upon filing of a Notice of Appeal and an Appeal Brief.

will not be entered because:

- they raise new issues that would require further consideration and/or search. (See note below).
- they raise the issue of new matter. (See note below).
- they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

\_\_\_\_\_  
\_\_\_\_\_

Applicant's response has overcome the following rejection(s):

Rejections of claim 1 under 35 U.S.C. 102 and claims 2-7 and 24-31 under 35 U.S.C. 103.

Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The amendments reduce the issues for appeal, but fail to overcome the rejection under 35 U.S.C. 112, first paragraph. The specification shows that an unidentified nucleic acid of claim 1 encodes a polypeptide that (see below under Other)

The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: None

Claims objected to: \_\_\_\_\_

Claims rejected: 1-7, 10, and 22-31

The proposed drawing correction filed on \_\_\_\_\_  has  has not been approved by the Examiner.

Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Other can form part of a functional AchR in the presence of an alpha subunit (see Ex.2 and Fig.1). There is no evidence that any of the claimed nucleic acids encodes a functional homooligomeric receptor. Due to the unpredictability discussed in Paper Nos. 8 and 13, one of skill in the art would have to perform undue experimentation to make or use the nucleic acids as intended.

SCOTT D. PRIEBE, PH.D  
PRIMARY EXAMINER